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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/727,306 | 12/03/2003 | Douglas B. Wilson | 114089.120 | 5202 |
| 23483 | 7590 | 04/26/2005 | EXAMINER | |
| WILMER CUTLER PICKERING HALE AND DORR LLP | | | LUONG, VINH | |
| 60 STATE STREET | | | ART UNIT | |
| BOSTON, MA 02109 | | | PAPER NUMBER | |
| | | | 3682 | |
| DATE MAILED: 04/26/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,306

Applicant(s)

WILSON, DOUGLAS B.

Examiner

Vinh T Luong

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3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/18/05 & 9/13/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachment.

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1. The Preliminary Amendment filed on August 30, 2004 has been entered.
2. The drawings were received on March 15, 2004. The Examiner accepts these drawings.
3. Claims 5 and 6/5 are objected to because of the following informalities: no antecedent basis is seen for the term "the *second* section" in claim 5. Appropriate correction is required.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "rigid," "semi-rigid," "flexible," or "non-deformable" in claims 1 and 7 is a relative term which renders the claim indefinite. The term "rigid," "semi-rigid," "flexible," or "non-deformable" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For example, it is unclear what range of Rockwell hardness of the material of the second section is required in order to be considered as "rigid, semi-rigid or *flexible*, or *non-deformable*."

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-13, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Lin (USP # 4,708,676).

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Regarding claim 1, Lin teaches a fatigue relieving/preventing apparatus associated with vehicle control means comprising:

a first section (unnumbered. See Attachment) that connects to a predetermined portion of the vehicular control means 2; and

a *flexible* section 22 that connects to the first section (Att.) that is capable of supporting at least a portion of a vehicular operator's body (Fig. 7).

Note that claim 1 recites alternatives "rigid, semi-rigid or *flexible*, or *non-deformable*," therefore, it is anticipated by prior art Lin that teaches one alternative.

Regarding claim 2, Lin's vehicular control means 2 is capable of controlling at least a *nautical vessel*, aircraft, or ground transportation vehicle.

Regarding claim 3, the portion of the body supported by the second section includes at least a forearm, wrist, or hand (Fig. 7).

Regarding claim 4, the first section (Att.) extends a length of a predetermined portion of the vehicular control means 2.

Regarding claim 5, the second section 22 includes at least two second sections 22 (Fig. 7) that each connect to the first section (Att.).

Regarding claim 6, the first section (Att.) is deformable since it is made of an elastic material such as PVC (polyvinylchloride). *Id.*, col. 3, lines 42-29.

Regarding claim 7, Lin teaches a fatigue relieving/preventing apparatus associated with a vehicular control means 2, comprising:

at least two discrete first sections (Att.) that each connect to a predetermined portion of the vehicular control means, and

a discrete rigid, semi-rigid or flexible, or non-deformable second section 22 that connects to each first section.

Regarding claim 8, the vehicular control means 2 is capable of controlling at least a *nautical vessel*, aircraft or ground transportation vehicle.

Regarding claim 9, the portion of the body supported by the deformable second section includes at least a forearm, wrist, or *hand*.

Regarding claim 10, the apparatus is adjustable for supporting different sizes or types of body portions by, e.g., deflating or inflating the air in chamber.

Regarding claim 11, each first section (Att.) is capable of being formed integral with the vehicular control means. On the other hand, it has long been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138 (CCPA 1946).

Regarding claim 12, each first section (Att.) is capable of being detached from the vehicular control means 2 as seen in Fig. 6.

Regarding claim 13, each first section (Att.) is deformable. Note that virtually any thing will be deformed if enough pressure is applied to it. See “flexible” in *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC 1969).

8. Claims 1-4 and 6-13, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Dickerson (USP # 4,875,386).

Regarding claim 1, Dickerson teaches a fatigue relieving/preventing apparatus associated with vehicle control means comprising:

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a first section 20 that connects to a predetermined portion of the vehicular control means (*i.e.*, the handlebar of the motorcycle in Figs. 1 and 2); and

a *flexible* section 18 that connects to the first section 20 that is capable of supporting at least a portion of a vehicular operator's body (Fig. 1).

Note that claim 1 recites alternatives “rigid, semi-rigid or *flexible*, or *non-deformable*,” therefore, it is anticipated by prior art Dickerson that teaches one alternative.

Regarding claim 2, Dickerson’s vehicular control means is capable of controlling at least a nautical vessel, aircraft, or ground transportation vehicle.

Regarding claim 3, the portion of the body supported by the second section includes at least a forearm, wrist, or hand (Fig. 1).

Regarding claim 4, the first section 20 extends a length of a predetermined portion of the vehicular control means.

Regarding claim 6, the first section 20 is deformable since it is made of an elastic material. *Id.*, col. 3, lines 10-12.

Regarding claim 7, Dickerson teaches a fatigue relieving/preventing apparatus associated with a vehicular control means (*i.e.*, the handlebar of the motorcycle in Figs. 1 and 2), comprising:

at least two discrete first sections 20 that each connect to a predetermined portion of the vehicular control means (a first section is for the right hand grip 14 and a second section is for the left hand grip 14. The use of right and left hand grips or fatigue relieving apparatus is conventional as seen in, e.g., USP 3,937,629 issued to Hamasaka), and

a discrete rigid, semi-rigid or flexible, or non-deformable second section 18 that

connects to each first section 20.

Regarding claim 8, the vehicular control means is capable of controlling at least a nautical vessel, aircraft or ground transportation vehicle.

Regarding claim 9, the portion of the body supported by the deformable second section includes at least a forearm, wrist, or *hand*.

Regarding claim 10, the apparatus is adjustable for supporting different sizes or types of body portions. *Id.*, col. 4, lines 9-19.

Regarding claim 11, each first section 20 is capable of being formed integral with the vehicular control means. The term "integral" is sufficiently broad to embrace construction united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326 (CCPA) and *In re Morris*, 43 USPQ2d 1753, 1757 (CAFC 1997). On the other hand, it has long been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison, supra*.

Regarding claim 12, each first section 20 is capable of being detached from the vehicular control means (by, e.g., sliding it out from the grip 14).

Regarding claim 13, each first section 20 is deformable since it is made of an elastic material. *Id.*, col. 3, lines 10-12.

9. Claims 1 and 7, as best understood, are rejected under 35 U.S.C. 102(b) as being *clearly* anticipated by Hamasaka (USP No. 3,937,629).

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-13, as best understood, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 6-10, 13, and 15-19 of copending Application No. 10720821 (Appl.'821). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-13 of this application and claims 1, 4, 6-10, 13, and 15-19 of Appl.'821 substantially claim common structures such as a first section and a second section connected to the first section. To the extent that the claims in this application call for the second section being "rigid, semi-rigid or flexible, or non-deformable," meanwhile, the claims in Appl.'821 call for the second section being "deformable," however, the terms "rigid, semi-rigid or flexible, or non-deformable" and "deformable" are relative terms. In fact, when the second section is rigid, semi-rigid, or flexible, it will be deformed if enough pressure is applied to it. Alternatively, when the second section is deformable, it inherently is flexible. See *Fredman v. Harris-Hub Co., Inc.*, *supra*. On the other hand, it is well settled that selection of known material suitable for its intended purpose would have been obvious. *In re Leshin*, 125 USPQ 416 (CCPA 1960) and MPEP 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the material of the second section claimed in the claims of this application such that it is deformable as claimed in claims 1, 4, 6-10, 13, and 15-19 of Appl.'821

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in order support a portion of the vehicular operator's body as taught or suggested by common knowledge in the art. *In re Leshin, supra*.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Allen (second section 41), Chang (Figs. 1-9), and Tager et al. (Figs. 1-15).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 571-272-7099. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

April 20, 2005



Vinh T. Luong
Primary Examiner

ATTACHMENT

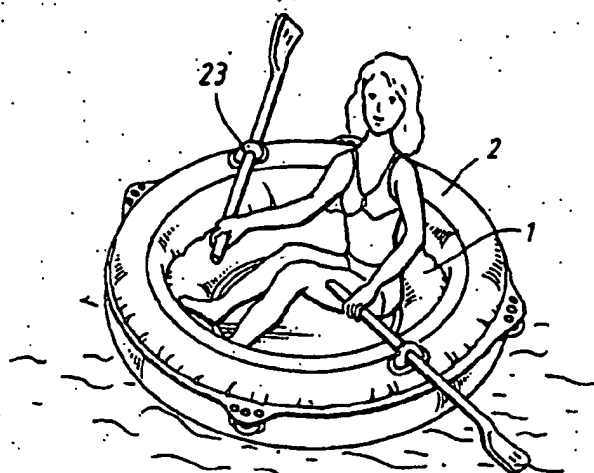


FIG. 6

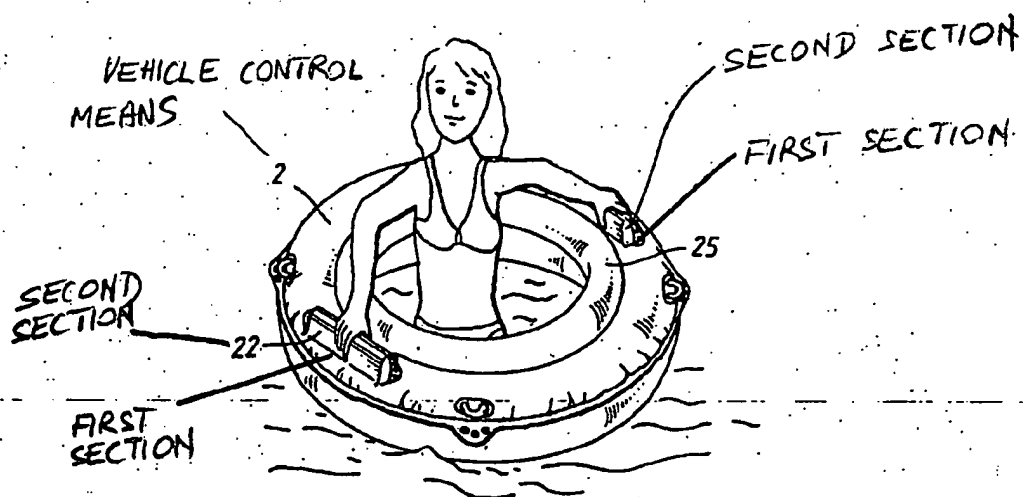


FIG. 7